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REMARKS

To date, the Examiner has not indicated that the subject matter of the information disclosure statement (IDS) filed February 18, 2005 has been properly considered. A copy of such IDS is submitted herewith. If the Examiner requires additional copies of any reference(s), applicant invites the Examiner to contact the undersigned. Documentation in the file wrapper of the instant application confirming the Examiner's consideration of the appropriate reference(s) is respectfully requested.

The Examiner has rejected Claim 4 under 35 U.S.C. 112, first paragraph, as being based on a disclosure that is not enabling. The Examiner alleges that "'experiments' critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure." In response, applicant emphasizes that "[i]n determining whether an unclaimed feature is critical, the entire disclosure must be considered. Features which are merely preferred are not to be considered critical." In re Goffe, 542 F.2d 564, 567, 191 USPQ 429, 431 (CCPA 1976). In re Mayhew, 527 F.2d 1229, 1233, 188 USPQ 356, 358 (CCPA 1976).

Further, limiting an applicant to disclosed features in the absence of limiting prior art would not serve the constitutional purpose of promoting the progress in the useful arts. Therefore, a rejection based on the grounds that a disclosed critical limitation is missing from a claim should be made only when the language of the specification makes it clear that the limitation is critical for the invention to function as intended. Broad language in the disclosure, including the abstract, omitting an allegedly critical feature, tends to rebut the argument of criticality. See MPEP 2164.08(c). For example, in the present case, there is no discussion of elements deemed critical in the specification. Further, it should be noted that there are no such elements in the Abstract, as filed.

Still yet, the Examiner has argued that "[i]t is unclear what 'experiments' are being performed in claim 4." Applicant respectfully disagrees and asserts that applicant's

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claimed "experiments" is to be read with regards to its plain and ordinary meaning, as evidenced by dictionary definitions, etc. For example, one exemplary dictionary definition of "experiment" includes "[a] test under controlled conditions that is made to demonstrate a known truth, examine the validity of a hypothesis, or determine the efficacy of something previously untried.." (*The American Heritage® Dictionary of the English Language, Fourth Edition*). Furthermore, applicant respectfully points out that, according to the claims, the "experiments [are performed] based on the information [associated with the utterances]," as claimed. Thus, the experiments may include, for example, tests, etc. that are performed based on information associated with the utterances, etc.

Additionally, the Examiner has rejected Claims 1, 4, and 11 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, the Examiner has argued that "Claim 11 is confusing since it has no actual structural elements; [and that in particular] it is drawn to a 'system', but the 'logic' cannot actually perform the functions recited." Applicant respectfully points out that Claim 11 has been amended to include a system "including a tangible computer readable medium" in order to avoid such rejection.

The Examiner has also argued that with "regard to claim 1, it is unclear how and why the 'transcriptions' are generated and what they are used for." First, applicant respectfully asserts that, as claimed, the transcriptions are received, which may include, but is not necessarily limited to being generated, as the Examiner notes. In addition, applicant claims that the "transcriptions of the utterances in the database [are received] from the at least one user interface utilizing the network" (emphasis added), thus indicating how the transcriptions are received. Second, applicant respectfully asserts that "a human is capable of utilizing the information and the transcriptions to improve a speech recognition application," as claimed, thus indicating why the transcription are received and what they are used for.

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Finally, the Examiner has rejected Claim 4, and has stated that "it is unclear what the 'experiments' are." Applicant respectfully points out the arguments made above, in responding to such rejection.

The Examiner has also rejected Claims 1, 4, 5, 6, 11, and 20 under 35 U.S.C. 102(b) as being anticipated by Mitchell et al. (U.S. Patent No. 5,799,273). In addition, the Examiner has rejected Claims 3, 16-19 and 21-24 under 35 U.S.C. 103(a) as being unpatentable over Mitchell in view of Kanevesky et al. (U.S. Patent No. 6,665,642). Applicant respectfully disagrees with such rejection, especially in view of the amendments made hereinabove to each of the independent claims. Specifically, applicant has amended each of the independent claims to include the subject matter of dependent Claims 4 and 16, at least in part.

With respect to the subject matter of dependent Claim 4, presently incorporated into each of the independent claims, the Examiner has relied on item S33 of Figure 6 in Mitchell to make a prior art showing of applicant's claimed technique "wherein the speech recognition process is improved by performing experiments based on the information."

Applicant respectfully asserts that item S33 of Figure 6 in Mitchell merely discloses "detect[ing] whether words are firm or infirm." Applicant notes, however, that such detection only includes detecting "whether the speech recognition engine application 11 has finished recognizing that word or not." Moreover, "[i]f the speech recognition engine application 11 has not finished recognizing that word, a word is still output as the most likely, but this could change," as disclosed in Mitchell.

Clearly, only detecting whether a word has been recognized, as in Mitchell, fails to even suggest any sort of experiments that improve the speech recognition process, as claimed. In particular, such detection itself, as in Mitchell, does not improve a speech

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recognition process, but instead is only utilized for forming a link between positions of firm words and corresponding audio (see Col. 8, line 60-Col. 9, line 1).

The Examiner is reminded that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, the identical invention must be shown in as complete detail as contained in the claim. *Richardson v. Suzuki Motor Co.* 868 F.2d 1226, 1236, 9USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. This criterion has simply not been met by the above reference, as noted above.

With respect to the subject matter of dependent Claim 16, presently incorporated into each of the independent claims in part, the Examiner has generally stated that Kanevesky shows applicant's claimed technique "wherein the information is selected from the group consisting of a dialog state, a gender of a speaker, and a date the utterances are transcribed," as presently claimed, but has failed to make a specific prior art showing of such claim language.

The Examiner is reminded that to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

First, applicant respectfully asserts that the first element of the *prima facie* case of obviousness and, in particular, the obviousness of combining the aforementioned

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references, as not been met. Applicant notes that the Examiner has stated that "it would have been obvious to one of ordinary skill in the art at the time of the invention to add these items [since] they make the system more user-friendly by storing more user-specific data." To the contrary, applicant respectfully asserts that it would not have been obvious to combine the teachings of the Mitchell and Kanevesky references, especially in view of the vast evidence to the contrary.

For example, Mitchell relates to speech recognition, while Mitchell relates to transforming web pages. To simply glean features from a speech recognition system, such as that of Mitchell, and combine the same with the *non-analogous art of web page transformation systems*, such as that of Kanevesky, would simply be improper. Speech recognition systems allow for recognizing audio, while web page transformation systems allow for changing web pages. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) In view of the vastly different types of problems speech recognition addresses as opposed to transforming web pages, the Examiner's proposed combination is inappropriate.

Further, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). Applicant respectfully asserts that simply nowhere in Mitchell is there any suggestion of "mak[ing] the system more user-friendly," as the Examiner notes. For example, Mitchell does not suggest mak[ing] the system user-friendly by storing any sort of data associated with a user, since in Mitchell the data

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processing apparatus stores data at a central server where such data is utilized by a plurality of authors (see Figure 11 in Mitchell).

Still yet, with respect to the third element of the *prima facie* case of obviousness, applicant respectfully asserts that simply nowhere in Kanevesky is there any disclosure of applicant's presently claimed technique "wherein the information is selected from the group consisting of a dialog state, a gender of a speaker, and a date the utterances are transcribed." In particular, applicant notes that Kanevesky only discloses a user record in a user database that includes an account number, a user name, user contact information, user billing information, user special needs information, user web browser information and user cache information (see Figure 5). Clearly, such user record does not include a dialog state, a gender of a speaker, or a date of the utterances, in the manner claimed by applicant, and especially not in view of the fact that Kanevesky does not even relate to any sort of speech recognition.

Thus, applicant respectfully asserts that at least the first and third elements of the *prima facie* case of obviousness has not been met, since the prior art references, when combined, fail to teach or suggest all of the claim limitations, as noted above.

Applicant further notes that the prior art is also deficient with respect to the remaining dependent claims. For example, with respect to Claim 18, the Examiner has admitted that Mitchell does not show applicant's claimed technique "wherein the utterances and the information are stored in the database, and the database is capable of being queried for results selected from the group consisting of a number of the utterances, a percentage of rejected utterances for a grammar, an average length of each utterance, a call volume in a predetermined range, a popularity of a grammar state, and a transcription management parameter." The Examiner has merely argued, however, that Kanevesky teaches such claim limitations.

Applicant again respectfully asserts that Kanevesky only discloses a user record in a user database that includes an account number, a user name, user contact

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information, user billing information, user special needs information, user web browser information and user cache information (see Figure 5). Clearly, such user information in Kanevesky does not even suggest any sort of utterances, call volume, grammar state or transcription, in the manner claimed by applicant.

In addition, with respect to Claim 22, the Examiner has relied on Col. 13, lines 35-50 in Kanevesky to make a prior art showing of applicant's claimed technique "wherein the at least one user interface includes additional icons for emitting previous and next utterances upon the selection thereof."

Applicant respectfully asserts that such excerpt from Kanevesky simply discloses "transform[ing] the information imparting functionality of certain elements into one more suitable for the color-blind." However, simply nowhere does such excerpt, or the entire Kanevesky reference, disclose "emitting previous and next utterances," in the manner claimed by applicant (emphasis added).

Further, with respect to Claim 24, the Examiner has relied on Col. 11, lines 55-60 in Kanevesky to make a prior art showing of applicant's claimed technique "wherein the at least one user interface includes a comment field for allowing a user to enter comments regarding a plurality of transcriptions."

Applicant respectfully asserts that such excerpt only discloses information imparting means for indicating types of information on a web page to a special needs user. Such information imparting means include animations, blinking text, and pop-up menus, as disclosed. Simply nowhere does Kanevesky even suggest any sort of comments, let alone "allowing a user to enter comments regarding a plurality of transcriptions," in the specific manner claimed by applicant.

Applicant notes that the Examiner has also rejected Claim 11 under 35 U.S.C. 101 as being directed toward non-statutory subject matter. Applicant has clarified Claim 11

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to include a computer program product "embodied on a tangible computer readable medium" in order to avoid such rejection.

Since the prior art references, when taken alone and in combination, fail to teach or suggest all of applicant's claim language, especially in view of the amendments made hereinabove, a notice of allowance or a proper prior art showing is respectfully requested.

Still yet, applicant brings to the Examiner's attention the subject matter of new Claims 27-30 below, which are added for full consideration:

"wherein the information includes the dialog state" (see Claim 27);

"wherein the dialog state includes a context in a dialog flow" (see Claim 28);

"wherein the information includes the gender of the speaker" (see Claim 29); and

"wherein the information includes the date the utterances are transcribed" (see Claim 30).

Thus, all of the independent claims are deemed allowable. Moreover, the remaining dependent claims are further deemed allowable, in view of their dependence on such independent claims.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 505-5100. The



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Commissioner is authorized to charge any additional fees or credit any overpayment to  
Deposit Account No. 50-1351 (Order No. BVOCP001).

Respectfully submitted,  
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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of )  
)  
Bertrand A. Damiba ) Group Art Unit: 2655  
)  
Application No. 09/769,880 ) Examiner: Smits, Talivaldis Ivars  
)  
Filed: January 24, 2001 ) Date: February 18, 2005  
)  
For: SYSTEM, METHOD AND COMPUTER )  
PROGRAM PRODUCT FOR A )  
DISTRIBUTED SPEECH RECOGNITION )  
TUNING PLATFORM )

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the above date.

Signed: 

Erica L. Farlow

INFORMATION DISCLOSURE STATEMENT  
UNDER 37 CFR §§1.56 AND 1.97(e)

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

The references listed in the attached PTO Form 1449(s) [at least one of which was provided by an Examiner(s) handling a possibly related patent application(s)], copies of which are attached (where appropriate), may be material to examination of the above-identified patent application. Applicants submit these references in compliance with their duty of disclosure pursuant to 37 CFR §§ 1.56 and 1.97. The Examiner is requested to make these references of official record in this application.

This Information Disclosure Statement is not to be construed as a representation that a search has been made, that additional information material to the examination of this application does not exist, or that these references indeed constitute prior art.

Applicants hereby state that no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing this certification after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in § 1.56(c) more than three months prior to the filing of the information disclosure statement.

Respectfully submitted,  
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Form 1449 (Modified)	Atty. Docket No. BVOCP001	Application No.: 09/769,880
Information Disclosure Statement By Applicant	Applicant: B. Damiba	
(Use Several Sheets if Necessary)	Filing Date: 01/24/2001	Group Art Unit: 2655

## U.S. Patent Documents

Examiner Initial	No.	Patent No.	Date	Patentee	Class	Sub-class	Filing Date
	A	6,208,964	03/27/2001	Sabourin	704	244	08/31/1998
	B	5,893,059	04/06/1999	Raman	704	256	04/17/1997
	C	5,819,220	10/06/1998	Sarukkai et al.	704	243	09/30/1996
	D	5,991,719	11/23/1999	Yazaki et al.	704	251	09/11/1998
	E						
	F						
	G						
	H						
	I						
	J						
	K						

## Foreign Patent or Published Foreign Patent Application

Examiner Initial	No.	Document No.	Publication Date	Country or Patent Office	Class	Sub-class	Translation	
							Yes	No
	L							
	M							
	N							
	O							
	P							

## Other Documents

Examiner Initial	No.	Author, Title, Date, Place (e.g. Journal) of Publication
	R	Sarukkai, Ramesh R., "Word Set Probability Boosting for Improved Spontaneous Dialogue Recognition: The AB/TAB Algorithms", the University of Rochester Computer Science Department, Technical Report 601, January 1996
	S	
	T	
Examiner		Date Considered

Examiner: Initial citation considered. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

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## PATENT POSTCARD

Docket No. BVOCP001 Appl. No.: 09/769,880 Date: 2/18/2005  
By: KJZ:EIF Filing Date: 1/24/2001 Express Mail No.:   
Inventor(s): B. Damiba  
Title: System, Method and Computer Program Product for a Distributed  
Speech Recognition Tuning Platform

The following has been received in the U.S. Patent &amp; Trademark Office on the date stamped below:

- X Information Disclosure Statement
- X PTO Form 1449
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